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Atty Docket No.: 10014137-1
App. Ser. No.: 10/052,334

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-7, 9-13, and 15-120 are pending in the present application, of which claims 1, 7, 13 and 19 are independent. Claims 1, 7, 13 and 19 have been amended and claim 20 is new. No new matter has been added.

Claims 1-7, 9-13, and 15-19 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Claims 1-6 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,560,639 to Dan et al. ("Dan"). Claims 7, 9-13, and 15-19 were rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over Dan in view of U.S. Patent No. 6,732,331 to Alexander ("Alexander"). These rejections are respectfully traversed.

Objection To The Specification

Applicants note that the Form 326 accompanying this Office Action indicates that the specification is objected to. However, no objection to the specification is set forth in the detailed Official Action. If the Examiner objects to the specification, he is respectfully requested to reissue the Official Action including the objection or via Examiner's Amendment along with the Notice of Allowance. If the Official Action is reissued, Applicants respectfully request that the time set for reply be reset to allow sufficient time to respond.

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Claim Rejection under 35 U.S.C. § 101

Claims 1-7, 9-13 and 15-19 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. These rejections are respectfully traversed because claims 1-7, 9-13 and 15-19 are directed to statutory subject matter under 35 U.S.C. § 101, and thus, are not required to recite that they are technologically embodied on a computer readable medium.

In response to Applicants' arguments, the Examiner appears to not disagree that claims 1 and 13 directed to a system, claim 7 directed to a method, and claim 19 directed to a computer readable storage medium are claims to statutory subject matter. However, the Examiner states that the limitation "a page storage medium" appearing in claims 1, 7, and 13 could somehow be interpreted as a "book of pages" and thereby render claims 1, 7, and 13 non-statutory.

Independent claims 1 and 13 have been amended to recite "a computer-readable page storage medium. Accordingly, the rejections of claims 1-6, 13 and 15-18 are believed to be overcome. Claim 7 has been amended to recite a "computer-implemented" method. Accordingly, the rejections of claims 7 and 9-12 are believed to be overcome. Independent claim 19 recites steps performed by a computer program when executed, wherein the computer program is stored on a computer-readable storage medium. The computerized method is believed to be statutory, and the rejection of claim 19 is believed to be overcome.

Claims 1, 7, 13 and 19 are thus believed to be directed to statutory subject matter in view of the above amendments and for the reasons set forth in Applicants' arguments, which are repeated below.

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Claims 1 and 13 are directed to a system, and thus, is directed to statutory subject

matter. "If a claim defines a useful machine or manufacture by identifying the physical

structure of the machine or manufacture in terms of its hardware or hardware and software

combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at

1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760." MPEP § 2106

(IV)(B)(2)(a).

Claim 7 is directed to a computer-implemented method. According to the MPEP, for

computer related processes to be statutory, "the claimed process must be limited to a practical

application of the abstract idea or mathematical algorithm in the technological arts. See

Alappat, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at

192, 209 USPQ at 10)." MPEP § 2106 (IV)(B)(2)(b). As an example of a statutory process,

the MPEP cites:

> A computerized method of optimally controlling transfer, storage and retrieval
> of data between cache and hard disk storage devices such that the most
> frequently used data is readily available.

Thus, the computer-implemented method is statutory. Insofar as the decisions cited

by the Examiner refer to a need for claims to be embodied on a computer readable medium,

Applicant points out that these decisions precede at least the *State Street* decision. See State

Street Bank & Trust Co. v. Signature Financial Group 149 F.3d 1368; 47 USPQ2d 1596 (Fed.

Cir. 1998).

Applicant refers the Examiner to MPEP § 2106 (IV)(B)(2) for a current evaluation of

what the U.S. Patent & Trademark Office considers statutory subject matter.

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Claim Rejection under 35 U.S.C. § 102

The test for determining if a reference anticipates a claim, for purposes of a rejection

under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed

combination, or the mechanical equivalents thereof functioning in substantially the same way

to produce substantially the same results. As noted by the Court of Appeals for the Federal

Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221

USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection

under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference
> disclosure of each and every element of the claimed invention,
> arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the

claimed invention, then the cited reference fails to anticipate the claimed invention and, thus,

the claimed invention is distinguishable over the cited reference.

Claims 1-6 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated

by the disclosure contained in Dan. This rejection is respectfully traversed.

The Examiner argues that Dan's statement that "[a] 'page' generally includes any

linked file in an internet" (Dan, col. 10, ll. 3-4) teaches the claimed step of "executing a

database script associated with the page through a tag embedded in the page to access

configuration information from a configuration database." Applicants respectfully disagree.

The portion of Dan's disclosure cited by the Examiner merely sets forth a general description

of a page in the context of a web site. Dan's general description of a page as a linked file

does not teach a tag as a link to a database script.

Claim 1 has been amended to recite,

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"a <u>database</u> script to be called from within <u>each</u> ~~the~~ tag; and

a configuration database storing page configuration information to be called or

queried by the script, <u>wherein each script called from each of the tags calls the same page</u>

<u>configuration information for each page of the site, wherein a change made to the page</u>

<u>configuration information called by each of the scripts results in the same changed</u>

<u>appearance for each page of the site.</u>"

Support for these limitations is found in Applicants' disclosure as follows:

"The tag 232 may be *a link to a database script* stored in database script module 214.

In operation, the server module 212 may detect the tag 232 and retrieve a database script

associated with the tag 232 from database script module 214. Database script module 214

may be a component of the database 130." Specification, p.4, ll.11-16 (emphasis added).

"The server 212 may then execute the database script retrieved from database script

module 214 of database 130 to obtain *configuring information* from the configuring

information module." Specification, p.4, ll. 18-20 (emphasis added). "[T]he *configuration*

information 218 may be stored in HTML. Specification, p.4, l. 28 (emphasis added).

"Fig. 3 is a flow diagram illustrating one embodiment of the method for presenting

pages 231 of a network site 110, 210 so that the pages 231 have a common look and feel."

Specification, p.5, ll. 20-21; Fig. 3 (emphasis added); see also p.6, ll. 27-33.

"The server 212 may then execute a database script 214 contained in or associated

with the tag 232." Specification, p.6, ll. 1-2 (emphasis added).

"Thus, a framework has been described allowing a database 130 *to control*

configuration of a whole network site 110, 210 where *the network site 110, 210 may include*

multiple pages 231. The *framework allows configuration data 218 of all pages 231 of a*

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network site 110, 210 to be changed without changing each page 231 of the network site 110,

210. This is accomplished *using a mechanism for inclusion (tag(s) 232)* provided by the

server 212." Specification, p.7, ll. 6-11 (emphasis added).

Dan's general description of a page as a linked file does not teach a database script or

a database script in each of the tags that calls the same page configuration in the

configuration database, wherein a change made to the page configuration information called

by each of the scripts results in the same changed appearance for each page of the site.

At least by virtue of the lack of disclosure of these elements, Dan fails to meet the

requirements of anticipation as described hereinabove. Therefore, at least for the reasons set

forth above, Claims 1-6 are believed to be allowable over Dan, and the Examiner is

respectfully requested to withdraw the rejection of Claims 1-6.

Claim Rejection under 35 U.S.C. § 103

The test for determining if a claim is rendered obvious by one or more references for

purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria
> must be met. First, there must be some suggestion or motivation,
> either in the references themselves or in the knowledge generally
> available to one of ordinary skill in the art, to modify the reference
> or to combine reference teachings. Second, there must be a
> reasonable expectation of success. Finally, the prior art reference
> (or references when combined) must teach or suggest all the claim
> limitations. The teaching or suggestion to make the claimed
> combination and the reasonable expectation of success must both
> be found in the prior art and not based on applicant's disclosure. *In
> re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of Claims 7, 9-13 and 15-19 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Dan in view of Alexander. This rejection is respectfully traversed because Dan considered singly or in combination with Alexander fails to disclose all of the elements of Claims 7, 9-13 and 15-19.

As discussed above, Dan does not disclose "a database script to be called from within the tag, wherein the script is identical for each page of the site; and a configuration database storing page configuration information to be called or queried by the script, wherein the script calls the same page configuration information for each page of the site, wherein a change made to the page configuration information called by the script results in the same changed appearance for each page of the site."

Independent claim 7 has been amended to recite,

"wherein each script executed through each of the tags calls the same configuration information for each page of the site, wherein a change made to the page configuration information called by each of the scripts results in the same changed appearance for each page of the site."

Independent claims 13 and 19 have been similarly amended. Support for these limitations is found in Applicants' disclosure as noted earlier.

In contrast to Applicants' claimed invention, Alexander teaches using style sheets to control web page appearance. Alexander, col. 6, ll. 45-56. Alexander does not teach each script executed through each of the tags calls the same configuration information, and also

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does not teach wherein a change made to the page configuration information called by each

of the scripts results in the same changed appearance for each page of the site. Therefore,

with respect to claims 7, 13, and 19, neither Dan nor Alexander, whether taken alone or in

combination, teach or disclose at least these limitations of claims 7, 13, and 19 and thus do

not anticipate or render obvious claims 7, 13, or 19. Applicants respectfully request that this

rejection be withdrawn.

In addition, Applicants respectfully submit that Dan fails to disclose other elements

set forth in claims 7, 9-13 and 15-19.

As set forth above, Dan fails to disclose a tag embedded in each page of a network-

based site. Thus, Dan fails to disclose the step of "executing a database script associated with

the page through a tag embedded in the page to access configuration information from a

configuration database," as recited in claims 7 and 19. Similarly, Dan fails to disclose

"means for executing a database script associated with the page through a tag embedded in

the page to access configuration information from a configuration database," as now recited

in claim 13.

The Official Action does not rely upon the disclosure contained in Alexander to make

up for these deficiencies in Dan and furthermore these features are not taught by Alexander.

The Official Action asserts that Alexander discloses the steps of receiving a request for a

page and retrieving the page from a page storage medium as set forth in claims 7 and 19, and

the means to perform such steps. Thus, even if Dan is combined with Alexander, the

proposed combination fails to make up for the deficiencies in Dan.

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At least for the reasons set forth above, Claims 7, 9-13, and 15-19 are believed to be allowable over Dan in view of Alexander, and the Examiner is respectfully requested to withdraw the rejection of Claims 7, 9-13, and 15-19.

Newly Added Claim

Claim 20 recites, "wherein the database scripts are identical." This feature is not taught or suggested by the prior art and thus claim 20 is believed to be allowable.

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<u>Conclusion</u>

In light of the foregoing, withdrawal of the rejections of record and allowance of this

application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would

assist in resolving any issues pertaining to the allowability of the above-identified

application, please contact the undersigned at the telephone number listed below. Please

grant any required extensions of time and charge any fees due in connection with this request

to deposit account no. 08-2025.

                                        Respectfully submitted,

                                        S. Brandon Keller et al.

Dated: June 20, 2005   By

                                        Ashok Mannava
                                        Registration No.: 45,301

                                        MANNAVA & KANG, P.C.
                                        8221 Old Courthouse Road
                                        Suite 104
                                        Vienna, VA 22182
                                        (703) 652-3822
                                        (703) 880-5270 (fax)

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